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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,162	01/22/2001	Robertson Graeme	PM276595	3966

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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

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DATE MAILED: 03/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/744,162

Applicant(s)

Graeme et al

Examiner

T. Yoon

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 1-22-01, Pre. Amndt
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-12 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1714

The underlines on pages 3 and 4 of the specification is objected.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recited "greater than 70 % w/w of the residues of at least one polymerizable acrylic monomer" and "0.3 - 5 % w/w of a finely divided compound" do not have supports in the originally filed specification and thus constitute NEW Matter. Also, the recited "an uncoated and unfilled acrylic polymer" constitutes NEW Matter. Negative limitation must have an exclusive support in the originally filed specification, *Ex parte grasselli*, 231 USPQ 394.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1714

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "unfilled acrylic polymer" in claims 1 and 8 is confusing since the composition contains up to 5% w/w of metal oxides and thus is filled. There is no definition with respect to said unfilled in the specification. The recited amounts in claim 9 is confusing since the basis for the at least one linking compound is not recited. The total amount in section (a) is more than 100%. The recited "hexanedioldiacrylate" in claim 4 improperly broadens the scope of claim 3 since it does not contain a polar hydroxy group.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1714

Claims 1-3, 7, 8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Delphin et al (WO 97/14749).

Delphin et al teach the instant invention in abstract and example 1. Thus, the instant invention lacks novelty.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minghetti et al (US 5,705,552).

Minghetti et al teach an acrylic composition for a sheet at cols. 7 and 8. The instant invention further recites at least one linking compound. However, such compounds such as hydroxyethylmethacrylate is taught at col. 3, lines 49-57. CAB-O-Sil M5 is silica as taught at col. 4, lines 23-35.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the hydroxyethylmethacrylate in examples since Minghetti teaches employing such compound as a crosslinker.

Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Smiley (US 4,145,477).

Smiley teaches the instant invention in examples 1-3. Thus, the instant invention lacks novelty.

Art Unit: 1714

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawase et al (US 5,753,362).

Kawase et al teach acrylic sheets having good mechanical properties in abstract and examples. Acrylic monomer having functional groups such as a hydroxyl or alkoxysily group (col. 12, lines 17-56), metal oxides (col 19, lines 15-20) and silica (col. 24, lines 1-2) are taught therein.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize a polymeric system comprising the recited amount of acrylic monomer(s), hydroxyethylmethacrylate and silica or metal oxide and to make an article thereof in Kawase et al since Kawase et al teach such modification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/March 12, 2002



TAE H. YOON  
PRIMARY EXAMINER